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09/852,447	05/09/2001	Gary E. Ross	3125.00003	5137

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Kenneth I. Kohn  
Kohn & Associates  
30500 Northwestern Hwy., Suite 410  
Farmington Hills, MI 48334

EXAMINER

HILLERY, NATHAN

ART UNIT PAPER NUMBER

2176

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/852,447

Applicant(s)

ROSS, GARY E.

Examiner

Nathan Hillery

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 and 51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to communications: Amendment filed on 7/20/05.
2. Claims 1 – 26 and 51 are pending in the case. Claims 1, 15 and 51 are independent.
3. The rejection of claims 1 – 26 and 51 under 35 U.S.C. 101 as being nonstatutory has been maintained.
4. The rejection of claims 1, 3 – 4, 6 – 9, 15 – 17, and 19 – 21 under 35 U.S.C. 112, first paragraph as failing to comply with the enablement requirement has been maintained.
5. The rejection of claims 1 – 26 and 51 under 35 U.S.C. 112, second paragraph as being indefinite has been withdrawn as necessitated by amendment.
6. The rejection of claims 1 – 26 and 51 under 35 U.S.C. 102(e) as being anticipatory has been withdrawn as necessitated by amendment.

### ***Election/Restrictions***

7. Applicant's election with traverse of Group I in the reply filed on 10/15/04 is acknowledged. The traversal is on the ground(s) that all of the claims relate to the same general concept, it is respectfully submitted that examination of all of the claims in a single application would be efficient, thereby promoting the grounds for the establishment of the restriction requirement practice. This is not found persuasive because the limitations that must be searched in order to examine Groups II - IV are not needed for the examination of Group I, thus causing serious burden on the Office.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1 – 26 and 51 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1 – 14 amounts to functional descriptive data. Because the claims are means plus function, the claimed invention is considered software per se. The rejection to these claims may be overcome if an inference to some form of hardware is claimed. Claims 15 – 26 refer to software per se and recite a system that is not tangibly embodied to a computer system. Claim 51 fails to practically describe an abstract idea; it has no tangible, concrete result. Furthermore, there is no real-world value regarding a true practical application. The claimed invention simply manipulates abstract ideas without practical application in the technological arts. Consequently, the claimed invention(s) do not require the technical or useful arts and, thus, fail to define patentable subject matter.

7. Further, to expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1, 3 – 4, 6 – 9, 15 – 17, and 19 – 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

12. Claims 1, 3 – 4, 6 – 9, 15 – 17, and 19 – 21 are single means claim(s), i.e., where a means recitation does not appear in combination with another recited element of means. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983).

See MPEP § 2164.08(a).

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 6, 7 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. Regarding claims 6 and 19, the term “intelligently suggesting more information” lacks comparative basis.

16. Regarding claim 7, the claim incorporates substantially similar subject matter as claim 6 and is rejected along the same rationale.

### ***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

18. Claims 1 – 26 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Iliff (US 5660176 A).

19. **Regarding independent claim 1**, Iliff teaches that *in situations where the MDATA system 100 cannot determine with sufficient certainty what is causing a particular problem (no diagnosis) or in a situation where a diagnosis is available but additional information is desirable, e.g., to determine a trend, a re-enter flag may be set by the system 100. At a decision state 520, the computer 102 determines if re-enter criteria are met for the current algorithm and patient situation. If so, the computer sets the re-enter flag at state 522 for this problem so a subsequent telephone consultation by the patient will allow for additional information to be added to the patient record by the system in full knowledge of the previous call. This additional information may yield a better diagnosis (Column 42, lines 21 – 34), Iliff teaches that Referring to FIGS. 7a, 7b, 7c and 7d, the top level flow 300 of the MDATA system 100 software will be described. The telephone number used to access the MDATA system 100 may vary in various embodiments of the system. If the sponsoring agency or hospital wishes to provide access to the MDATA system 100 at no cost to the caller, then a toll-free 800 service number can be used. If the sponsoring agency or hospital wishes to recover the costs of running the MDATA system 100 from the caller, it may use a pay-per-call or premium charge number (e.g., 900 service). "Current Procedural Terminology" (CPT-4) codes*

*are available to describe and bill third party payers for telephone consultations. They are a listing of the descriptive terms and identifying codes for reporting medical services and procedures. CPT-4 codes are the most widely accepted nomenclature for reporting physician services to insurance companies (Column 25, lines 30 – 45) and Iliff teaches that The MDATA system's authoring language, however, is designed to allow physicians to transfer their knowledge into a computer program that can be directly accessed by non-medically trained personnel (Column 14, lines 23 – 26), compare with **augmenting means for eliciting information for medical codes through the analysis of clinician-entered information and predetermined criteria input.***

20. **Regarding dependent claim 2**, Iliff teach that *a patient response database, having a trace response file for each patient, stored in the computer, wherein the patient response database is created by the evaluation process, a patient medical history database stored in the computer having a past medical history file for each patient, wherein the patient medical history database is created (Column 4, line 63 – Column 5, line 2), compare with **storage means for recording inputted predetermined criteria, entered information and conclusions thereof into a database.***

21. **Regarding dependent claim 3**, Iliff teaches that *as another embodiment of the MDATA system, a person desiring medical advice and having access to a personal computer (PC) loads a program into the PC to produce a stand-alone medical diagnostic and treatment advice (SA-MDATA) system (Column 4, lines 18 – 22), compare with **said augmenting means is a software program.***

22. **Regarding dependent claim 4**, Iliff teaches that *the algorithm processor 160 loads node #101, represented by node block 214. The work list is empty, so the system 100 goes right to playing back message#101 which presents another menu of choices to the user. The Next list has four nodes for possible branch points. In this example, the patient selects menu option "1" for a chest pain complaint. The parser evaluates the Next list based on the patient selection and branches to node #2200 (Column 20, lines 29 – 36), compare with* **said augmenting means is further defined as a selection option mechanism.**

23. **Regarding dependent claims 5 and 6**, Iliff teaches that *in situations where the MDATA system 100 cannot determine with sufficient certainty what is causing a particular problem (no diagnosis) or in a situation where a diagnosis is available but additional information is desirable, e.g., to determine a trend, a re-enter flag may be set by the system 100. At a decision state 520, the computer 102 determines if re-enter criteria are met for the current algorithm and patient situation. If so, the computer sets the re-enter flag at state 522 for this problem so a subsequent telephone consultation by the patient will allow for additional information to be added to the patient record by the system in full knowledge of the previous call. This additional information may yield a better diagnosis (Column 42, lines 21 – 34), compare with* **said augmenting means includes at least one of data addition means for adding information and data substituting means for substituting information and said augmenting means includes an elicitation database for intelligently suggesting more information for**



**medical codes, alternative conclusions, and predetermined criteria to support the conclusions.**

24. **Regarding dependent claim 7**, Iliff teaches that *"Current Procedural Terminology" (CPT-4) codes are available to describe and bill third party payers for telephone consultations. They are a listing of the descriptive terms and identifying codes for reporting medical services and procedures. CPT-4 codes are the most widely accepted nomenclature for reporting physician services to insurance companies* (Column 25, lines 39 – 45), compare with **said augmenting means includes eliciting conclusions selected from the group consisting of medical payment codes, billing codes, treatment codes, and service codes.**

25. **Regarding dependent claim 8**, Iliff teaches that *each patient has their own associated symbol table. A portion of a symbol table 212 is shown in FIG. 5b. The symbol table is loaded at run time with memory variables that hold patient specific data (age, sex, and items from medical history) and algorithm specific data. The items in the symbol table can be flagged for storage to the patient's medical history* (Column 18, lines 5 – 11), compare with **said augmenting means includes analysis of predetermined criteria input wherein the criteria includes phrases, words, numbers and symbols relating to the conclusions.**

26. **Regarding dependent claim 9**, Iliff teaches that *as another embodiment of the MDATA system, a person desiring medical advice and having access to a personal computer (PC) loads a program into the PC to produce a stand-alone medical diagnostic and treatment advice (SA-MDATA) system* (Column 4, lines 18 – 22),

compare with **utilized on a device selected from the group consisting of hand-held devices, portable computers, desktop computers, wireless devices, web-based technology systems, touch screen devices, typing devices, and electronic devices.**

27. **Regarding dependent claim 10**, Iliff teaches that *before the MDATA system stores any information, the system verifies its accuracy. To accomplish this task, "confirmation loops" are used. Any piece of information that will become a part of the patient's medical record is sent through a confirmation loop where the system asks the patient to verify the accuracy of the information that the system has collected. The confirmation loop enables the system to verify new patient information and make corrections before it enters this information into the patient's medical record* (Column 13, lines 55 – 64), compare with **accuracy confirming means for confirming the accuracy of previously entered information.**

28. **Regarding dependent claim 11**, Iliff teaches that *in addition, the MDATA system 100 is currently using optical character recognition technology to digitize its medical database. Then, using indexing techniques, the MDATA system 100 is able to search for and retrieve any information desired. For example, the system can search for the character string "headache" and retrieve any amount of surrounding text or graphic information* (Column 60, lines 9 – 15), compare with **searching means for locating words and phrases.**

29. **Regarding dependent claim 12**, Iliff teaches that *the load node () routine 194 in util.c builds the node block structure 196 in memory by first reading in a node record*

190 from the node table 174. Then linked lists are attached to the pointers help, play, next and work. These lists come from the list files 176, in subdirectory path *Vist\listxx\xyy*, where *xyy* is the node number, wherein each list file 192 is associated with a unique node (Column 17, line 65 – Column 18, line 4), compare with **linking means for linking to a listing and description of predetermined criteria**.

30. **Regarding dependent claim 13**, Iliff teaches that *the user responds to questions and directions displayed on the computer screen via a computer input device, such as a keyboard or mouse* (Column 4, lines 23 – 26), compare with **free-text entry means for entering text into said system**.

31. **Regarding dependent claim 14**, Iliff teaches that *the computer 102 prompts the patient for the patient ID (identification) number (PIN) that is assigned during the registration process. The patient registration process 252 will be described in conjunction with FIGS. 9a and 9b. Proceeding to a decision state 361, the computer 102 determines whether the PIN is valid* (Column 29, line 14 – 20), compare with **security means for restricting access to said system**.

32. **Regarding independent claim 15**, the claim incorporates substantially similar subject matter as claim 1, and is rejected along the same rationale.

33. **Regarding dependent claim 16**, Iliff teaches that *as another embodiment of the MDATA system, a person desiring medical advice and having access to a personal computer (PC) loads a program into the PC to produce a stand-alone medical diagnostic and treatment advice (SA-MDATA) system* (Column 4, lines 18 – 22),

compare with **accessible through communication systems selected from the group consisting of the Internet, Intranet, Extranet, and electronically.**

34. **Regarding dependent claims 17 – 26**, the claims incorporate substantially similar subject matter as claims 4 – 14, and are rejected along the same rationale.

35. **Regarding independent claim 51**, the claim incorporates substantially similar subject matter as claim 1, and is rejected along the same rationale.

### ***Response to Arguments***

36. Applicant's arguments filed 7/20/05 have been fully considered but they are not persuasive.

37. In response to Applicant's arguments that the rejection(s) made to the claims under 35 USC 101 have been overcome, it should be noted that Applicant's amendment(s) to overcome such a rejection simply adds intended use to the preamble which does not preclude the rationale given in the rejection(s) of the claims under 35 USC 101 above.

38. In response to Applicant's arguments that the claims do comply with the enablement requirement, it should be noted that the Office Action does not hold that the means claims do not appear in combination with another recited element as has been misinterpreted by Applicant on p 6, lines 20 – 21. However, the Office does maintain that the means recitation does not appear in combination with another recited element of means as was and still is explained in the rejection of the claim(s) under 35 USC 112, first paragraph above.

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39. In response to Applicant's arguments that Iliff does not anticipate the amended claim(s), it should be noted that a new interpretation was used as necessitated by such amendment(s). The Office has used the broadest, most reasonable interpretation in the new rejection(s) of the claim(s) as outlined above in the rejection(s) under 35 USC 102(e).

40. In response to applicant's argument(s) that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a system or method that augments clinician documentation to better comply with governmental regulatory coding regiments in order to classify the inpatient stay most appropriately to obtain the most correct payment; the conversion of descriptive information into information for medical codes, which results in accurate medical coding and payment reimbursement; a method or system that encourages the user to enter more detailed information to obtain accurate medical coding) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

41. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NH

*William S. Bashore*  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**  
10/16/2005